UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/597,363	07/25/2008	Robert Bruce Nicholson	GB920030112US1	9883

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EXAMINER
WONG, TITUS

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2184	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

	Application No.	Applicant(s)
Office Action Summary	10/597,363	NICHOLSON ET AL.
	Examiner	Art Unit	
	TITUS WONG	2184	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>10 December 2010</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>22-32 and 34-51</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>22-32 and 34-51</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All   b)☐ Some * c)☐ None of:

      1.☒ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

The amendment filed on December 20, 2010 has been received and entered.

Applicant's Amendments to Claims have been received and acknowledged.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
conditions and requirements of this title.

Claim 32 is rejected under 35 U.S.C. 101 because the claimed recitation of a

use, without setting forth any steps involved in the process, results in an improper

definition of a process, i.e., results in a claim which is not a proper process claim under

35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and

Clinical Products, Ltd. v. *Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

As such, the claim is not limited to statutory subject matter and is therefore non-

statutory.

Claim Objections

Claims 22-32 and 34-51 are objected to because of the following informalities:

Claim 22, line 8, claim 34, line 10, claim 42, line 16, before "logical", -the-

should be inserted-.

Claim 32, line 8, "temporarily" should read –temporary-.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 22-32 and 34-51 rejected under 35 U.S.C. 112, second paragraph,

as being indefinite for failing to particularly point out and distinctly claim the

subject matter which applicant regards as the invention.

In claim 22, line 7, the term "configurable" indicates that the storage

controller may or may not be configured as a back-up storage controller. It is

interpreted that the storage controller is not configured as a back-up storage

controller. Similar problems exist in claims 32, 34, and 42.

In claim 22, lines 8 and 9, "logical units of the storage controller" lack

antecedent basis it was not mentioned previously. Similar problems exist in

claims 34 and 42.

In claim 32, line 2, the associating lacks proper antecedent basis since it

was not mentioned previously.   Applicants should clearly indicate which

associating is being referred to since the storage controller is also associating all ports and the storage controller and can also be interpreted as an association unit.

In claim 32, lines 5 and 6, it is not clear what is meant by a logical unit to storage area network switch zone relationship

In claim 32, line 6, the term "modifiable" is indefinite since it may or may not be modified.

In claim 32, line 7, the term "available" is indefinite since it can indicate that the data storage may or may not be used.

Claim 32 provides for the use of temporary storage but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Applicant is required to review the claim and correct all language which does not comply with 35 U.S.C. § 112, second paragraph.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form

the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 22-32 and 34-51 are rejected under 35 U.S.C. 102(b) as being

anticipated by Ito et al. (US Publication No. 2003/0014600 A1) hereafter referred to as

Ito'600.

Referring to claim 22, Ito'600, as claimed, an apparatus to control access to

logical units (<u>computer gain access to logical units, see para. [0057] and Fig. 1</u>) where a

plurality of logical units are accessible via a network (<u>fiber channel 113, see Fig. 1</u>) by at

least one port (<u>ports 102-104 and 108-112, see Fig. 1</u>), comprising: a definition unit to

define a set (<u>Group ID (GID), see para. [0070]</u>) so as to comprise at least one port that

requires access to certain logical units (<u>GID allocated to the host computers when they</u>

<u>are grouped into arbitrary groups, see para. [0070]</u>), the set having a name and being a

named set; and an association unit operable to associate the named set (<u>LUN</u>

<u>management access table and WWN_S_ID_GID conversion table, see paras. [0051]</u>

<u>and [0052]</u>) with the certain logical units to enable a determination of identification

information for the at least one port by referencing the name; where a storage controller

is configurable as a back-up storage controller by associating all ports of the storage

controller in all named sets and by selecting which named set that the logical units of

the storage controller are associated with (associations are dynamically changed and storage systems can be used for "backup" of data, see paras. [0063]-[0064] and [0092]).

As to claim 23, Ito'600 discloses a logical unit comprises an addressable entity that accepts commands (FCP_CDB stores command information of SCSI , see paras. [0052]-[0056] and Fig. 4) and a port comprises an addressable entity that sends commands (host computer transmits the frame storing the command to a storage system to be accessed, see para. [0057]).

As to claim 24, Ito'600 discloses the certain logical units comprise a part of a storage device (storage subsystem 101, see Fig. 1) accessed via a storage area network (Fiber channel 113, see Fig.1 and para. [0004]).

As to claim 25, Ito'600 discloses the storage area network uses a SCSI protocol (SCSI command, see para. [0039]).

As to claim 26, Ito'600 discloses the storage area network comprises a Fibre Channel interface (Fiber Channel, see para. [0039]).

As to claim 27, Ito'600 discloses said definition unit comprises means for coupling together a plurality of ports that are members of the set and providing a locating address for the set (GID allocated to the host computers when they are grouped into arbitrary groups, see para. [0070]).

As to claim 28, Ito'600 discloses said definition unit is operable to logically identify those ports that are members of the set using port identification information (WWN (N_Port_Name), see para. [0070]).

As to claim 29, Ito'600 discloses said definition unit is at a first location, and where said association unit is at a second location (see Fig. 1).

As to claim 30, Ito'600 discloses identification information is changeable in response to changes in port configurations (LUN access management table can be flexibly configured, see paras. [0091]-[0093], and Fig. 11).

As to claim 31, Ito'600 discloses logical units are identified by logical unit numbers (LUN, see para. [0053]).

As to claim 32, Ito'600 discloses said association unit that performs the associating comprises part of a first storage controller (storage control device 116 for controlling data write/read to and from storage unit groups, see para. [0063] and Fig. 1), where said storage controller that is configurable as a back-up storage controller comprises a second storage controller, where logical units of said second storage controller are usable as temporary storage (storage systems can be used for "backup" of data, see paras. [0063]-[0064] and [0092]), and where a logical unit to storage area network switch zone relationship of the second storage controller is modifiable such that data storage represented by the second storage controller is available to a host computer (host computers 108-112, see Fig. 1 and para. [0062]) running an application that requires temporarily storage (storage system 101 includes a cache 120 as means for improving the response to the host computer, see para. [0064]).

Note claims 34 and 42 recite the corresponding limitations of claim 22. Therefore they are rejected based on the same reason accordingly.

Note claim 35 recites the corresponding limitations of claim 23. Therefore they are rejected based on the same reason accordingly.

Note claim 36 recites the corresponding limitations of claim 24. Therefore it is rejected based on the same reason accordingly.

Note claims 37 and 45 recite the corresponding limitations of claim 25. Therefore they are rejected based on the same reason accordingly.

Note claims 38 and 46 recite the corresponding limitations of claim 26. Therefore they are rejected based on the same reason accordingly.

Note claims 39, 43, and 44 recite the corresponding limitations of claim 27. Therefore they are rejected based on the same reason accordingly.

Note claims 40 and 47 recite the corresponding limitations of claim 28. Therefore they are rejected based on the same reason accordingly.

Note claim 41 recites the corresponding limitations of claim 30. Therefore it is rejected based on the same reason accordingly.

As to claim 48, Ito'600 discloses the operation of associating occurs at a plurality of locations (the tables can be set by user through the input unit of the maintenance terminal equipment, see para. [0066]).

Note claim 49 recites the corresponding limitations of claim 31. Therefore it is rejected based on the same reason accordingly.

Note claim 50 recites the corresponding limitations of claims 28 and 30. Therefore it is rejected based on the same reason accordingly.

As to claim 51, Ito'600 discloses a given one of a group of ports is one of a physical or logical group of ports (<u>ports 102-104 and 108-112, see Fig. 1 and WWN in Fig. 12</u>).

Response to Arguments

Applicant's arguments filed on 12/10/2010 have been fully considered but they are not persuasive.

At the outset, Applicants are reminded that claims subject to examination will be given their broadest reasonable interpretation consistent with the specification. *In re Morris, 127 F.3d 1048, 1054-55 (Fed. Cir. 1997)*. In fact, the "examiner has the duty of police claim language by giving it the broadest reasonable interpretation." *Springs Window Fashions LP v. Novo Industries, L.P.*, 65 USPQ2d 1862, 1830, (Fed. Cir. 2003). Applicants are also reminded that claimed subject matter not the specification, is the measure of the invention. Disclosure contained in the specification cannot be read into the claims for the purpose of avoiding the prior art. *In re Sporck*, 55 CCPA 743, 386 F.2d, 155 USPQ 687 (1986).

With this in mind, the discussion will focus on how the terms and relationships thereof in the claims are met by the references. Response to any limitations that are not in the claims or any arguments that are irrelevant and/or do not relate to any specific claim language will not be warranted.

Applicants argued that "Ito'600 does not teach a storage controller is configurable as a back-up storage controller by associating all ports of the storage controller in all named sets and by selecting which named set that logical units of the storage controller are associated with." (Page 8 and 9 of Amendment)

Examiner does not agree with Applicants. As set forth in the art rejections, Ito'600 discloses a storage controller is configurable as a back-up storage controller by associating all ports of the storage controller in all named sets and by selecting which named set that the logical units of the storage controller are associated with (associations are dynamically changed and storage systems can be used for "backup" of data, see paras. [0063]-[0064] and [0092]). Also, as mentioned in the above 35 U.S.C 112th 2nd rejection, "configurable as a back-up storage controller..." is interpreted as the storage controller having the *capability* of a back-up storage controller but it is not necessarily a back-up storage controller.

In summary, Ito'600 teaches the claimed limitations as set forth.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

Contact Information

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Titus Wong whose telephone number is (571) 270-1627.

The examiner can normally be reached on Monday-Friday, 10am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Dr. Henry Tsai can be reached on (571) 272-4176. The fax phone number

for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

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Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TW

/Henry W.H. Tsai/
Supervisory Patent Examiner, Art Unit 2184